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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,815	03/09/2001	Masahito Yamamoto	862.C2144	5395
5514	7590	12/08/2005	EXAMINER PHAM, THIERRY L	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ART UNIT 2624	PAPER NUMBER

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/801,815	<b>Applicant(s)</b> YAMAMOTO, MASAHIRO	
	<b>Examiner</b> Thierry L. Pham	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 9/14/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30, 46-49 and 52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30, 46-49 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

- This action is responsive to the following communication: RCE filed on 9/14/05.
- Replacement Drawing sheets filed on 9/14/05 has been considered and entered by examiner.
- Amendment to the specification filed on 9/14/05 has been considered and entered by examiner.
- Claims 1-30, and 46-49, and 52 are pending; claims 31-45, and 50-51 have been canceled.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/05 has been entered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 52 recites the limitation "the apparatus" in first line of claim 52. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-15, 25-30, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al (EP 975145).

Regarding claim 10, Yamamoto discloses a system (data communication print system, fig. 1) comprising:

- a generating unit (host computer 4 of fig. 1 for generating transfer path profile as shown in fig. 10) that generates transfer information describing a combination of a plurality of devices on the basis of device information corresponding to each of the plurality of devices (i.e. input and output devices such as scanners and printers respectively, figs. 9-10, for example, SCAN 5 to LP5-3 and LP5-1), the plurality of devices including a proxy device which converts a data format of image data (i.e. LIPSIV format, fig. 10), a first device (SCAN 5, fig. 10) which can transmit image data of which the data format can be converted by the proxy device (inherently, the system as shown in figs. 1 & 10 includes a proxy device for converting input image data into an output image data such as LIPSIV and/or JPEG), and a second device (LP5-3, fig. 10) which can process image data of which the data format is converted;
- an acquisition unit (server 5 for acquiring transfer path profile, fig. 10, cols. 14-16) that acquires the transfer information;
- a reception unit (receiving input data from scanner via network, fig. 1, cols. 13-16) that, at the proxy device represented by the acquired transfer information, receives the image data from the first device represented by the acquired transfer information through a network;
- a conversion unit that, at the proxy device (inherently, the system as shown in figs. 1 & 10 includes a proxy device for converting input image data into an output image data such as LIPSIV and/or JPEG) represented by the acquired transfer information, converts a data format of the received image data; and
- a transmission unit (transmitting image data via network, fig. 1, cols. 13-16) that transmits the converted image data from the proxy device represented by the acquired transfer information to the second device represented by the acquired transfer information through a network.

Regarding claim 11, Yamamoto further discloses the device according to claim 10, further comprising announcement unit that announces (confirmation means, figs. 8-14, cols. 13-16) to the network, information representing a data format receivable by said reception means and information representing a data format transmittable by said transmission means.

Regarding claim 12, Yamamoto further disclose the device according to claim 10, wherein said conversion unit performs at least one of conversion of the data format (i.e. lipsiv data format, fig. 10 and fig. 23), conversion of an image resolution, and conversion of an image depth (fig. 10).

Regarding claim 13, Yamamoto further discloses the device according to claim 10, wherein said conversion unit performs at least one of image trimming, image enlargement, image reduction, image deformation, image edge extraction, and image color conversion (converting image data into specified resolution, figs. 23-24).

Regarding claim 14, Yamamoto further discloses he device according to claim 10, wherein said conversion unit performs at least one of conversion of the image data to coded data by encoding processing such as character recognition, conversion of the image data to a structured image format by image region separation processing and encoding processing, and conversion of coded data to the image data by rasterization image processing (rasterization, col. 21).

Regarding claim 15, Yamamoto further discloses the device according to claim 10, wherein said conversion unit performs conversion of a data compression scheme (JPEG compression, figs. 23-25) or conversion of a data compression ratio.

Regarding claims 25-30: Claims 25-30 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 10-15 (respectively); therefore, claims 25-30 are rejected for the same rejection rationale/basis as described in claims 10-15 above.

Regarding claim 48: Claim 48 recite limitations that are similar and in the same scope of invention as to those in claim 10 except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. RAM 41, fig. 5 of Yamamoto) for storing computer programs, hence claim 48 would be rejected using the same rationale as in claim 10.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 16-24, 46-47, 49, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al (EP 975145), and in view of Beser (US 6370147).

Regarding claim 1, Yamamoto discloses a system (data communication print system, fig. 1) comprising:

- a generating unit that generates (host computer 4 of fig. 1 for generating transfer path profile as shown in fig. 10) transfer information (transfer path profile #2, fig. 10, fig. 8 shows how a transfer path profile is generated, col. 5, lines 48-50) describing a combination of a plurality of devices (i.e. input and output devices such as scanners and printers respectively, figs. 9-10, for example, SCAN 5 to LP5-3 and LP5-1) on the basis of device information (i.e. device profile information, fig. 7) corresponding to each of the plurality of devices (for each devices connected via a network, fig. 1);
- an operation unit that causes (user control console, figs. 8-13, cols. 13-16) a user to select transfer information from the generated transfer information;
- a reception unit that carries (receiving input data from scanner via network, fig. 1, cols. 13-16) image data from an input device represented by the selected transfer information on the basis of

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the selected transfer information (fig. 10 shows a transfer path profile for transmitting image data SCAN 5 to LP5-3 and LP5-1); and

- a transmission unit that transmits (transmitting image data from scanner to printer via network, fig. 1, cols. 13-16) the received image data to an output device (laser printer, fig. 1 and fig. 4) represented by the selected transfer information on the basis of the selected transfer information (based upon transfer path profile, i.e., "copy scan 5 to LP5-3", fig. 10).

Yamamoto also discloses device information (device profile, fig. 7) includes a transfer protocol such as FTP, and LPD, but fails to teach and/or suggest whether this device is actively and/or passively starts data communication with an external device in accordance with an instruction from the external device.

Beser, in the same field of endeavor for data communication system, teaches network devices such as printer and facsimile machine categorized as passively starts data communication (abstract, figs. 19-21 and col. 3, lines 5-20) and cable modem categorized as actively starts data communication (fig. 19, col. 27, lines 33-40) with external device in accordance with an instruction from the external device.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the device profile (fig. 7) of Yamamoto to include an indication that device profile as shown in fig. 7 is a passive device as taught by Beser because of a following reason: (•) the method allows passive network devices without implementing a dynamic host configuration protocol (abstract, Beser); (•) to accurately label which devices connected via a network is a passively and/or actively executing data communication; by doing so, it allows the system of Yamamoto to search efficiently, for example, searching devices profile that only passively executes data communication.

Therefore, it would have been obvious to combine Yamamoto with Beser to obtain the invention as specified in claim 1.

Regarding claim 2, Yamamoto further discloses the system according to claim 1, wherein said reception unit transmits the selected transfer information (transfer path profile, fig. 10) to the first device in order to control the first device, and said transmission unit (network, fig. 1)

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transmits the selected transfer information to the second device in order to control the second device.

Regarding claim 3, Yamamoto further discloses the system according to claim 1, further comprising announcement unit that announces (confirmation means, figs. 8-14, cols. 13-16) to a network, device information (device information, fig. 7) containing information representing that said reception unit controls the input device as an active device (devices that are available to communicate and transfer data, fig. 9) and information representing that said transmission unit controls the output device as an active device.

Regarding claim 4, Yamamoto further discloses the system according to claim 1, wherein the transfer information contains a protocol (transfer protocol, fig. 10) used to transfer the data, a data format (data format, fig. 10) of the data to be transferred, and an address (network address, fig. 10) representing a destination to which the data is to be transferred (fig. 10).

Regarding claim 5, Yamamoto further discloses a system comprising:

- a generating unit that generates (host computer 4 of fig. 1 for generating transfer path profile as shown in fig. 10) transfer information (transfer path profile #2, fig. 10, fig. 8 shows how a transfer path profile is generated, col. 5, lines 48-50) describing a combination of a plurality of devices (i.e. input and output devices such as scanners and printers respectively, figs. 9-10, for example, SCAN 5 to LP5-3 and LP5-1) on the basis of device information (i.e. device profile information, fig. 7) corresponding to each of the plurality of devices (for each devices connected via a network, fig. 1);
- an operation unit that causes (keyboard 33, fig. 5 and devices, figs. 8-13, cols. 13-16) a user to select a desired transfer path corresponding to the generated transfer information;
- an acquisition unit that acquires (server 5 for acquiring transfer path profile, fig. 10, cols. 14-16) transfer information corresponding to the selected transfer path; input means (scanner, fig. 1) for inputting image data at an input device represented of the acquired transfer information;
- and a transmission unit that transmits (network, fig. 1) the input image data (transferring data from scanner 5 to printer 3 as shown in transfer path profile #2, fig. 10) from the first device to a



second device represented by the acquired transfer information on the basis of the acquired transfer information.

Yamamoto also discloses device information (device profile, fig. 7) includes a transfer protocol such as FTP, and LPD, but fails to teach and/or suggest whether this device is actively and/or passively starts data communication with an external device in accordance with an instruction from the external device.

Beser, in the same field of endeavor for data communication system, teaches network devices such as printer and facsimile machine categorized as passively starts data communication (abstract, figs. 19-21 and col. 3, lines 5-20) and cable modem categorized as actively starts data communication (fig. 19, col. 27, lines 33-40) with external device in accordance with an instruction from the external device.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the device profile (fig. 7) of Yamamoto to include an indication that device profile as shown in fig. 7 is a passive device as taught by Beser because of a following reason: (●) the method allows passive network devices without implementing a dynamic host configuration protocol (abstract, Beser); (●) to accurately label which devices connected via a network is a passively and/or actively executing data communication; by doing so, it allows the system of Yamamoto to search efficiently, for example, searching devices profile that only passively executes data communication.

Therefore, it would have been obvious to combine Yamamoto with Beser to obtain the invention as specified in claim 5.

Regarding claim 6, Yamamoto further discloses the system according to claim 5, wherein said transmission unit transmits the input image data to a proxy device (file server, fig.1, cols. 13-16) represented by the acquired transfer information, and said proxy device transfers the received image data to an output device represented by the acquired transfer information (transferring data based upon transfer path profile s shown in fig. 10) in accordance with a request from the output device.

Regarding claim 7, Yamamoto further discloses the system according to claim 5, wherein said transmission means transmits the input image data to a proxy device represented by the acquired transfer information, and said proxy device (server, fig. 1, cols. 13-16) transfers the received image data by controlling an output device represented by the acquired transfer information in accordance with the acquired transfer information.

Regarding claim 8, Yamamoto further discloses the system according to claim 5, wherein said transmission unit transmits the acquired transfer information to the external device (i.e., printer, fig. 1).

Regarding claim 9, Yamamoto further discloses the system according to claim 5, wherein the transfer information contains a protocol (protocol, fig. 10) used to transfer the data, a data format of the data to be transferred (data format, fig. 10), and an address (address, fig. 10) representing a destination to which the data is to be transferred (transfer path profile, fig. 10).

Regarding claims 16-24: Claims 16-24 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-9 (respectively); therefore, claims 16-24 are rejected for the same rejection rationale/basis as described in claims 1-9 above.

Regarding claims 46-47: Claims 46-47 recite limitations that are similar and in the same scope of invention as to those in claims 1 & 5 (respectively) except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. RAM 41, fig. 5 of Yamamoto) for storing computer programs, hence claims 46-47 would be rejected using the same rationale as in claims 1 & 5 (respectively).

Regarding claim 49, Yamamoto discloses a computer comprising:

- a first acquisition unit that acquires (server 5 for acquiring transfer path profile, fig. 10, cols. 14-16) first device information corresponding to first device (i.e. device profile for input device as shown in fig. 7);

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- a second acquisition unit that acquires second device information corresponding to second device (i.e. device profile for output device as shown in fig. 34);
- a generating unit that generates for generating transfer information (host computer 4 of fig. 1 for generating transfer path profile as shown in fig. 10) describing a combination of a plurality of devices on the basis of the acquired first device information and the acquired second device information (fig. 10 shows a transfer path profile for transmitting image data SCAN 5 to LP5-3 and LP5-1).

Yamamoto also discloses device information (device profile, fig. 7) includes a transfer protocol such as FTP, and LPD, but fails to teach and/or suggest whether this device is actively and/or passively starts data communication with an external device in accordance with an instruction from the external device.

Beser, in the same field of endeavor for data communication system, teaches network devices such as printer and facsimile machine categorized as passively starts data communication (abstract, figs. 19-21 and col. 3, lines 5-20) and cable modem categorized as actively starts data communication (fig. 19, col. 27, lines 33-40) with external device in accordance with an instruction from the external device.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying the device profile (fig. 7) of Yamamoto to include an indication that device profile as shown in fig. 7 is a passive device as taught by Beser because of a following reason: (●) the method allows passive network devices without implementing a dynamic host configuration protocol (abstract, Beser); (●) to accurately label which devices connected via a network is a passively and/or actively executing data communication; by doing so, it allows the system of Yamamoto to search efficiently, for example, searching devices profile that only passively executes data communication.

Therefore, it would have been obvious to combine Yamamoto with Beser to obtain the invention as specified in claim 49

Regarding claim 52, Beser further teaches the apparatus according to claim 49, wherein the first device information indicates data transfer being executed actively or passively by the first device for each protocol teaches network devices such as printer and facsimile machine

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categorized as passively execute data communication and cable modem categorized as actively executes data communication (col. 27, lines 33-40) with which the data transfer is performed in compliance therewith and the second device information indicates data transfer being executed actively or passively by the second device for each protocol with which the data transfer is performed in compliance therewith, and wherein the generated transfer information describes the combination of the plurality of devices and a protocol used between the plurality of devices.

### *Response to Arguments*

Applicant's arguments filed 9/14/05 have been fully considered but they are not persuasive.

- Regarding independent claims 1, 5, 16, 20, 46-47, the applicant argued the combined prior arts of record fails to teach and/or suggest a motivation to combine.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, (●) the method allows passive network devices without implementing a dynamic host configuration protocol (abstract, Beser); (●) to accurately label which devices connected via a network is a passively and/or actively executing data communication; by doing so, it allows the system of Yamamoto to search efficiently, for example, searching devices profile that only passively executes data communication.

Applicant's arguments, see pages 20-21, filed 9/14/05, with respect to the rejection(s) of claim(s) independent claims 10, 25, and 48 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretation of previously applied art (EP 975145).

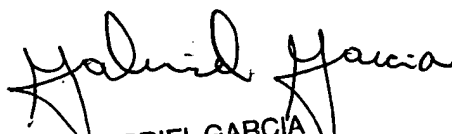
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

  
GABRIEL GARCIA  
PRIMARY EXAMINER